

### **REMARKS**

The claims currently pending in the application are claims 71-112. Claims 1-70 have been cancelled pursuant to the Preliminary Amendment. Claim 103-112 are newly presented as per this amendment.

### **Claim Objections**

It is noted that Examiner has objected to claims 72, 76 and 97 and suggested that Applicants amend claim 71 by replacing "radio signal source" with "radio frequency receiver", claim 76 by replacing "during the material" with "during presentation of the material" and claim 97 by replacing "user of the hand-held device" with "user of a hand-held device". Applicants have adopted the Examiner's last two suggested amendments. Applicants have not replaced "radio signal source" with "radio frequency receiver", as "radio signal source" is a term that is defined in the preamble of the claim.

### **Claim Rejections Under 35 USC § 112**

It is further noted that Examiner has rejected claim 74 under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Examiner states that claim 74 refers to "the display" but does not specify if "the display" refers to "a display device" in claim 1, line 1 or "a display disposed on the hand-held device" in claim 73. Applicants have amended claims 73 and 74 to reflect that the display disposed on the hand-held device is a device display.

Examiner has also rejected claim 72 under 35 USC §112, first paragraph for failing to comply with the written description requirement. Examiner states that the Specification fails to adequately describe "the radio signal source is a decoder box for demodulating the promotional

opportunities received from the source” and interpreted the decoded box to be a FM receiver so as to advance prosecution on the merits. Applicants have amended claim 72 to reflect that it is a decoder device which demodulates the promotional opportunities received from the source as described in the Specification. See page 7 lines 20-30 for support.

### Claim Rejections Under 35 USC § 103

Claims 71-75 have been rejected under 35 USC §103(a) as being unpatentable over *McMahon* in view of *Nemirofsky*, claim 76 has been rejected over *Walkingshaw* in view of *Von Kohorn*, claims 77-80 have been rejected over *Walkingshaw* and *Von Kohorn* in view of *McMahon*, claims 81-84 have been rejected over *McMahon* in view of *Gottlich* and *Nemirofsky*, claims 85 and 88 have been rejected over *McMahon*, *Gottlich*, and *Nemirofsky* in view of *Bullock*, claims 86 and 87 have been rejected over *McMahon*, *Gottlich*, *Nemirofsky* and *Bullock* in view of *Brooks*, claims 89, 90, 91, and 95 have been rejected over *Nemirofsky* in view of *Gaucher*, claim 96 has been rejected over *Nemirofsky* and *Gaucher* in view of *Robb*, claims 92, 93 and 94 have been rejected over *Nemirofsky* and *Gaucher* in view of *McMahon*, claim 97 has been rejected over *Nemirofsky* in view of *McMahon* and *Dominguez*, claim 100 has been rejected over *Nemirofsky* in view of *Wagner*, claim 101 has been rejected over *Nemirofsky* in view of *Wagner* and *Lappington*, and claims 98, 99 and 102 have been rejected over *Nemirofsky* in view of *Boggs*.

The Examiner contends that the *McMahon* reference discloses a hand-held device for receiving promotional opportunities from a display device and a radio signal source, the hand-held device comprising a photodetector, a radio frequency receiver, and a memory. The Examiner further contends that *McMahon* teaches the concurrent use of optical and RF forms of communication between the hand-held device and a point-of-sale terminal.

The Examiner contends that the *Nemirofsky* reference discloses a hand-held device which receives data from a display device with an imbedded CPU and other circuitry and a decoding means.

Applicants respectfully submit that claims 71-74 are not rendered obvious by *McMahon* in view of *Nemirofsky*.

With respect to independent claim 71, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *McMahon* in view of *Nemirofsky*. Specifically, *McMahon* does not disclose the concurrent use as here claimed of optical and RF forms of communication between the consumer data device and a point-of-sale terminal as contended by the Examiner, but rather merely discloses the use of optical communication with the consumer data device as an alternative to spread-spectrum RF. (See Col 3 line 66 – Col 4 line 2). *McMahon* teaches away from concurrent use of optical communication and RF in multiple locations because the consumer data device is associated with a specially manufactured kiosk machine or a checkout register, and is not intended to be used in a variety of locations. (See Col 2 lines 32-44, Col 3 lines 12-16, Col 3 lines 38-39 and Col 3 lines 57-61.) Unlike the device of *McMahon*, the hand-held device of the claimed invention works with various types of display devices and radio sources available at multiple different locations. (See page 13 lines 2-22 for support.)

*McMahon* further teaches away from *Nemirofsky* in that *McMahon* discloses that coupons and rain checks are selectively downloaded at a purchasing location by the user in response to a present need or desire of the shopper to make a purchase while already at the purchasing location, effectively encouraging additional or alternate purchasing behavior. (See Col 2 lines 40-44 and Col 4 lines 3-9.) In contrast, *Nemirofsky* and the claimed device encourages users of the hand-held devices by their response to the video signals presented on display devices to

encourage them to visit a purchasing locations or provider of a certain product in hopes of having them redeem received promotional opportunities. (See Col 1 lines 14-24.) Thus, the promotion opportunities of *McMahon* are downloadable at the purchase location, instead of at a nonpurchase location such as the user's home. The kiosk in *McMahon* encourages the user to make additional or different purchases while in the store; the claimed invention encourages users to come to a store or visit a web site. In addition, *McMahon* allows the user to select the desired opportunity from a predetermined list, whereby the user of the claimed device chooses to receive or retain an opportunity presented.

*McMahon* also teaches away from including the decoding means of *Nemirofsky* because although *McMahon* provides that coupons can be optically received, there is no suggestion that is directly from the display device as in *Nemirofsky*. (See Figs. 5 and 6.) Rather, the *McMahon* reference teaches away from *Nemirofsky* by showing the user directing the card device not at the display device, but at a separate transmission optical point. In addition, there would be no reason to add substantially nonvisible data to the video in *McMahon* because the video in *McMahon* is not being broadcast to a wide range of viewers some of whom will not have a hand held device such as in *Nemirofsky*, but rather the video is individually directed to a single user. Moreover, since the data is not being broadcast to some viewers who will not have a device, there would be no reason to include the primary function of the decoding means, demodulation of the video signals, in *McMahon*. Thus, the skilled artisan would not be lead to combine *Nemirofsky* and *McMahon* to provide the presently claimed combination.

In addition, the *McMahon* reference only vaguely discloses the inclusion of a photodetector; neither form, content, placement nor actual functioning is described in the specification or depicted in the drawing. (See Col 2 lines 11-13 and Fig 2.) Accordingly, it is

curious as to the form and operation of the inclusion of such photo-receiver in *McMahon*, let alone its use for teaching a combination with another reference.

Applicants have amended independent claim 71 to clarify that the radio signals are being sent to the hand-held device in response to video signals with auxiliary data and the promotional opportunities are transmitted to the hand-held device by the auxiliary data. Thus, claims 71-74 are submitted to be patentably unobvious over the combination of *McMahon* and *Nemirofsky*.

With respect to claim 76, the Examiner contends that the *Walkingshaw* reference discloses a device for providing one or more promotional opportunities prestored on the device in conjunction with material presented by a source from the reception of auxiliary data from the source. The Examiner further contends that the device comprises a receiver, a central processing unit and other circuitry to compare auxiliary data against prestored data.

The Examiner contends that the *Von Kohorn* reference discloses a device which generates and dispenses promotional opportunities that is hand held.

Applicants respectfully submit that claim 76 is not rendered obvious by *Walkingshaw* in view of *Von Kohorn*.

With respect to independent claim 76, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *Walkingshaw* in view of *Von Kohorn*. Specifically, the *Walkingshaw* reference discloses that the user pre-selects desired products or categories of interest and thereafter automatically receives and downloads promotional opportunities relating to these selections from the source. (See Col 2 lines 28-33, lines 43-45 and lines 52-57.) The user's selection of desired products or categorical information is preprogrammed at a central station based on information received from the user in the form of a complete questionnaire before providing the device to the user. (See Col 2 line 58 - Col 3 line 2.) In contrast, the claimed device operates fundamentally different in that the promotional

opportunities are preprogrammed on the hand-held device by the source without input by the user before being given to the user, and these promotional opportunities may then be triggered on the hand-held device by the user's reception of auxiliary data. (See page 20 lines 21-29 for support.) Thus, this embodiment of the claimed device is for one time use for the user, and once a trigger or series of triggers are received the device is not capable of being further used except for redemption by the user.

In addition, the *Walkingshaw* device requires no interaction with the user during presentation of video signals and teaches away from doing so. (See Col 2 lines 23-26 and Col 4 lines 29-32.) The claimed invention is fundamentally different in that it requires a user to utilize the hand-held device and to interact with programming material by positioning the hand-held device to receive information such as from a display device. (See page 5 line 28 – page 6 line 4 and page 14 lines 22 – page 15 line 3 for support.) Accordingly, *Walkingshaw* does not contemplate such interaction nor suggest it.

The *Walkingshaw* device is intended to be used exclusively in the subscriber's home to receive the video signals, since the user need only take printed coupons from the device and need not move it from place to place. (See Col. 2 lines 23-26, Col 5 lines 28-44 and 60-63.) The device in *Walkingshaw*, when receiving video signals as described in the preferred embodiment, utilizes an antenna or cable to directly receive the video signals from the video source and therefore does not indirectly receive video signals such as through optical detection of a display device. (See Col 3 lines 11-14 and Fig. 1 and 1A.) In contrast, the claimed device is not directly connected to a display device and is intended to be taken from place to place so that the user may take advantage and receive a promotional opportunity whenever the opportunity presents itself.

There would be no advantage to providing the *Walkingshaw* device with the capability of being portable since it must be connected to an antenna or cable box to directly receive the video

signals. (See Col 3 lines 11-14 and Figs. 1 and 1A.) In addition, the portability of the paper coupons and lack of user interaction directly with the device teaches away from making the device portable and redeemable.

The apparatus of the *Von Kohorn* reference teaches away from the *Walkingshaw* reference and the claimed device in that the user enters the product information to preprogram the device to obtain information and coupons relating to the user's future purchase. (Col 1 lines 40-45 and 62-66 and Col 4 lines 8-13 and lines 27-37.) Thereafter, the products are presented to the user on the display device and the user is provided with an opportunity to download these opportunities. Applicants' structure does not require preloading, thereby encouraging user to download a new promotional opportunity relative to the content on the video signals, such that the user in the claimed invention may respond immediately to a new opportunity.

The device of the *Von Kohorn* reference is further described in the preferred embodiment by which a user manually enters product information and verification data into the unit to generate a coupon. (See Col 7 lines 2-5 and lines 30-33.) The *Von Kohorn* device provides promotional opportunities to the user that may be redeemed with paper coupons or magnetic cards. (See Col 8 lines 5-18.) Unlike the claimed device, promotional opportunities under the *Von Kohorn* reference are not directly redeemable with the hand-held device. In fact, there is no suggestion to modify the references as claimed by the Examiner. Thus, the skilled artisan would not be lead to combine *Von Kohorn* and *Walkingshaw* to provide the presently claimed combination.

Applicants have amended independent claim 76 to clarify that the promotional opportunities are pre-stored by the sponsor and not as a result of the user's predilection of desired promotional opportunities or categories thereof. Thus, claims 76-80 are submitted to be patentably unobvious over the combination of *Von Kohorn* and *Walkingshaw*.

With respect to claim 81, the Examiner contends that the *McMahon* reference discloses a hand-held device for receiving promotional opportunities presented by a source, the hand-held device comprising a receiver, a memory, and a display. The Examiner further contends that the *Gottlich* reference discloses a hand-held device that can receive and display relative promotional opportunities in order to encourage behavior that will achieve the next award level identified. The Examiner finally contends that the *Nemirofsky* reference discloses a hand-held device that receives promotional opportunities from a source with an imbedded CPU, memory, and a nonalphanumeric display.

Applicants respectfully submit that claims 81-84 are not rendered obvious by *McMahon* and *Gottlich* in view of *Nemirofsky*.

With respect to independent claim 81, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *McMahon* and *Gottlich* in view of *Nemirofsky*. Specifically, users of the *Gottlich* reference are provided with human readable text on the device display that provides them with a current total of account activity, a new discount offer or special redemption and/or participation programs. (See Col 15 lines 31-37.) The presentation of the text on the device display indicates to the user a target goal for future activity which, when met, will provide the user with an additional award relative to the new award level. (See Figs. 3A, 3B and 3C.) The award levels that the user may achieve are personalized and individually targeted for the user based on past activities. (See Col 6 lines 13-21.) In contrast, *Nemirofsky* and *McMahon* both teach away from the customized award levels of *Gottlich* as none of the devices generate new award programs based on past behavior as in *Gottlich*. In *McMahon*, the user directly selects and downloads coupons to a device at the store. (See Col 2 lines 40-44, Col 4 lines 22-28 and Fig. 6.) In *Nemirofsky*, the user selectively receives promotion data depending on the content displayed on the television. (See Abstract and



Col 3 lines 49-57.) Thus, there would be no motivation in *Nemirofsky* or *McMahon* to encourage relative behavior relating to award levels.

The *Gottlich* reference teaches personalized and individually targeted responses by use of its device. (See Col 6 lines 52-59.) In contrast, the claimed invention encourages the user to use the hand-held device to receive one or more promotional opportunities of increasing value based on a predetermined pattern of behavior, such as a user viewing multiple commercials or watching every quarter of a football game, as predetermined by the sponsor prior to distribution of the devices. (See page 15 line 20 - page 16 line 17 and page 17 lines 27 - page 18 line 4 for support.)

The reader/writer device in *Gottlich* receives its information from the POS or from manual input. (See Col 6 lines 34-36, Col 7 line 63 - Col 8 line 2 and Fig. 2E.) In addition, the reader/writer device is located in stores, while the user card is individualized and transportable. (See Col 6 lines 34-36 and 60-62, Col 8 lines 23-27 and Col 14 lines 12-21.) In contrast, the user in *Nemirofsky* receives promotion data directly on the transportable card and brings the card to the POS to redeem the promotion data. Thus, claims 81-84 are submitted to be patentably unobvious over the combination of over *McMahon* and *Gottlich* in view of *Nemirofsky*.

As discussed above, the Examiner contends that the *McMahon*, *Gottlich* and *Nemirofsky* disclose the hand-held device of independent claim 81. With respect to claim 85 and 88, the Examiner contends that the *Bullock* reference discloses a device with a display comprising separate indicator LEDs, one for each type or class of promotional opportunities or auxiliary data received by the device, indicating to the user which promotional opportunities are available.

Applicants respectfully submit that claims 85 and 88 are not rendered obvious by *McMahon*, *Gottlich* and *Nemirofsky* in view of *Bullock*.

With respect to dependent claim 85, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *McMahon*, *Gottlich* and *Nemirofsky* in view of *Bullock*. The device in *Bullock* utilizes lights and LEDs to indicate the type or class of coupon data that is being downloaded to the device so that the user can, after downloading, decide whether to print and therefore use the coupon. (See Col 7 lines 25-39.) In contrast, the claimed device utilizes successive LEDs to demonstrate relative levels of promotional opportunities, such as by lighting multiple LEDs a user of the device will receive a larger prize. (See page 15 lines 20-27 for support.) In addition, unlike the device in *Bullock* where a single LED is lit at a time relative to the content on the television, multiple LEDs on the claimed invention may become lit when the user has earned such lights based on continuing participation or winning a larger prize.

The *Bullock* reference further teaches away from the *McMahon* and *Nemirofsky* references because the device in *Bullock* requires no user interaction to download promotional opportunities from the source; rather, user interaction is only required to print out the coupons from the device. In *McMahon*, the user directly selects and downloads coupons to a device at the store. (See Col 2 lines 40-44, Col 4 lines 22-28 and Fig. 6.) In *Nemirofsky*, the user selectively receives promotion data depending on the content displayed on the television. (See Abstract and Col 3 lines 49-57.) Thus, there would be no motivation in *Nemirofsky* or *McMahon* to encourage relative behavior relating to award levels.

The inclusion of a printer in the *Bullock* device teaches away from making redemptions directly by the device in *Nemirofsky*. In *Nemirofsky*, there is no reason to print coupons from the device since the device is capable of being directly redeemed in a store. (See Col 3 lines 49-57 and Col 5 lines 45-50.) Accordingly, the skilled artisan would not be lead to combine *McMahon*, *Gottlich*, *Nemirofsky* and *Bullock* to provide the presently claimed combination.

In this connection, the observation is appropriate of the Court of Customs and Patent

Appeals in the case In re Shaffer, 108 USPQ 326, 328-329 (1956), wherein it stated at page 329:

... it is not enough for a valid rejection to view the prior art in retrospect once an applicant's disclosure is known. The art applied should be viewed by itself to see if it fairly disclosed doing what an applicant has done. If the art did not do so, the references may have been improperly combined.

Applicant submits that it is only by hindsight that Examiner is motivated to find and combine the above references to attempt to arrive at the claimed invention. In *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990), the Federal Circuit found that "...it is insufficient that prior art shows similar components, unless it also contains some teaching, suggestion, or incentive for arriving at the claimed structure." Applicant submits that no teaching, suggestion, or incentive has been shown.

The Federal Circuit recently made clear that the identification of prior art statements that appear to suggest a claimed limitation does not establish a prima face case of obviousness, without a finding as to the *specific understanding or principle within the knowledge of the skilled artisan* that would have motivated one with no knowledge of the intention to make the claimed combination. *In re Kotzab*, 55 USPQ 1313 (Fed. Cir. 2000).

Applicants have amended dependent claim 85 to clarify the successive relationship between the LEDs.

As discussed above, the Examiner contends that the *McMahon*, *Gottlich*, *Nemirofsky* and *Bullock* disclose the hand-held device of dependent claim 85. With respect to claims 86 and 87, the Examiner contends that the *Brooks* reference discloses using a plurality of LEDs of different colors, in order to provide color-coded messages as indicators.

Applicants respectfully submit that claims 86 and 87 are not rendered obvious by *McMahon*, *Gottlich*, *Nemirofsky* and *Bullock* in view of *Brooks*.

With respect to dependent claim 86, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *McMahon*, *Gottlich*, *Nemirofsky* and *Bullock* in view of *Brooks*. Specifically, the LEDs used in *Brooks* are used to indicate the mode of operation of the device, battery strength or proper operation of the device. (See Col 7 line 49 – Col 8 line 4 and Col 4 lines 15-22.) In contrast, the claimed device utilizes the LEDs to act as the indication display for displaying relative levels of promotional opportunities to the user, and not for indicating whether the device is properly operating. (See page 15 line 20 – page 16 line 29 for support.)

The device in *Brooks* measures a users exposure to programming material, and provides benefits to the user of the device based upon proper and continuance usage. (See Abstract and Col 1 line 63 - Col 2 line 3 and Col 4 lines 62-64.) Accordingly, the device in *Brooks* promotes compliance with predescribed procedures for use of the device including carrying the device and docking it instead of encouraging user interaction with the device. In contrast, the device in *Bullock* rewards the user with the capability of selectively printing coupons that have been downloaded to the device. (See Col 3 lines 19-27.) In *McMahon*, the user directly selects and downloads coupons to a device at the store. (See Col 2 lines 40-44, Col 4 lines 22-28 and Fig. 6.) In *Nemirofsky*, the user selectively receives promotion data depending on the content displayed on the television. (See Abstract and Col 3 lines 49-57.) Accordingly, *Brooks* teaches away for providing rewards for user interaction, and instead teaches providing rewards for user compliance. Therefore, the skilled artisan would not be lead to combine *McMahon*, *Gottlich*, *Nemirofsky* and *Bullock* in view of *Brooks* to provide the presently claimed combination.

With respect to claims 89-96, the Examiner contends that the *Nemirofsky* reference discloses a hand-held device comprising a receiver, a central processing unit and other circuitry, a memory, and a computer interface means. The Examiner next contends that the *Gaucher* reference discloses a device which dispenses hand-held devices to users of the hand-held device for the benefit of providing the hand-held devices from a common terminal. The Examiner also contends that the *McMahon* reference discloses a hand-held device with a radio frequency receiver.

Applicants respectfully submit that claims 89, 90, 91, 95 and 96 are not rendered obvious by *Nemirofsky* in view of *Gaucher*, and claims 92-94 are not rendered obvious by *Nemirofsky* and *Gaucher* in view of *McMahon*.

With respect to independent claim 89, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *Nemirofsky* in view of *Gaucher*. Specifically, the *Gaucher* reference is not relevant because Applicants are not trying to protect nor describe a system for dispensing hand-held devices, but rather Applicants are claiming a hand-held device with novel features. Accordingly, the skilled artisan is not led to combine the *Nemirofsky* and *Gaucher* references.

Applicants have amended independent claim 89 to clarify that the hand-held device is receiving auxiliary data relating to promotional opportunities from a source, and that the processing of the promotional opportunities by the computer is remote.

Notwithstanding the foregoing, the device in *Nemirofsky* discloses the use of a bar code reader for use with in-store redemption of the hand-held device. (See Col 7 lines 42-45 and Col 16 lines 2-11.) In contrast, the claimed invention uses a computer interface means to communicate with a computer to remotely process promotional opportunities. (See page 9 lines 9-20, page 22 line 26 – page 23 line 3 and page 23 lines 10-27.)

With respect to claim 97, the Examiner contends that the *Nemirofsky* reference discloses a method of interactive advertising and promotion in connection with a user's observance of events comprising transmitting auxiliary data related to such events, wherein the auxiliary data is associated with sponsors and carries promotional opportunities of special significance relative to the event, the sponsor and the promotional opportunities are of special value to the user, providing means for receiving the auxiliary data for the user of a hand-held device while it views the events on a display device, and providing benefit to the user of the hand-held device of selectively receiving the promotional opportunities, the hand-held device being capable of retaining indication of having received the promotional opportunities.

The Examiner contends that *McMahon* teaches the concurrent use of optical and RF forms of communication between a hand-held device and a point of sale terminal.

The Examiner contends that *Dominguez* teaches a method utilizing a hand-held device for receiving auxiliary data from a radio signal source which can be used while the user attends a special event, such as racing.

Applicants respectfully submit that claim 97 is not rendered obvious by *Nemirofsky* and *McMahon* in view of *Dominguez*.

With respect to independent claim 97, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *Nemirofsky* and *McMahon* in view of *Dominguez*. Specifically, Applicants refer to its aforementioned comments regarding *Nemirofsky* and *McMahon* with respect to claim 71.

The device in *Dominguez* is a radio monitor that receives radio frequencies that are directly heard by the user of the hand-held device. (See Abstract, Col 1 lines 12-20, Col 2 lines 9-12 and Col 2 lines 43-63.) In contrast, the radio frequency signals of the *McMahon* reference are used to transmit coupons to the hand-held device, and therefor teaches away from listening to

these signals. (See Col 1 lines 30-37 and Col 2 lines 5-7.) Accordingly, the *Dominguez* does not teach the transmission or reception of auxiliary data. Consequently, there would be no motivation to combine *Dominguez* with *Nemirofsky* and *McMahon*. Thus, the skilled artisan would not be lead to combine *Dominguez* with *Nemirofsky* and *McMahon* to provide the presently claimed combination.

With respect to claim 100, the Examiner contends that the *Nemirofsky* reference discloses a method for purchasing a desired product through interactive advertising from a source, the method comprising: supplying a user with a hand-held device capable of capturing a promotional opportunity relative to a desired product from the source, capturing the promotional opportunity relative to the desired product on the hand-held device by the user, and supplying a third party with the hand-held device of the user containing the promotional opportunity.

The Examiner contends that the *Wagner* reference discloses a transaction and data system which would allow a hand-held device with a computer interface capable of connection to a computer with Internet access to purchase desired products.

Applicants respectfully submit that claim 100 is not rendered obvious by *Nemirofsky* in view of *Wagner*.

With respect to independent claim 100, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *Nemirofsky* in view of *Wagner*. Specifically, the system in *Wagner* is used for facilitating banking and financial transactions over a network. (See Col 1 lines 7-33 and Fig. 22B.) However, there is no suggestion in *Wagner* that any transaction is a result of the receipt of promotional opportunities on a hand-held device. In contrast, the smart card of *Nemirofsky* is used at a point of purchase location, value redemption or benefit redemption venue. (See Col 1 lines 14-24.) Accordingly, the skilled artisan would not be lead to combine *Nemirofsky* and *Wagner* to provide the presently claimed combination.

With respect to claim 98, 99 and 102, the Examiner contends that the *Nemirofsky* reference discloses a method of interactive advertising and promotion relative to material presented by a display device comprising transmitting auxiliary data during presentation of the material, when the auxiliary data is associated with a sponsor of the material and carries promotional opportunities, providing means for receiving the auxiliary data for users of a hand-held device while they view the events on a display device, and providing a benefit to the user of the hand-held device for selectively receiving the promotional opportunities, the hand-held device being capable of retaining indication of having received the promotional opportunities, this indication comprises a means for presenting to the user the promotional opportunities received by means of the auxiliary data.

The Examiner contends that the *Boggs* reference discloses a toy camera that resembles a snap-shot camera and a simulated lens which simulates a real camera for the advantage of providing a familiar mechanism to simulate an image pickup device.

Applicants respectfully submit that claims 98, 99 and 102 are not rendered obvious by *Nemirofsky* in view of *Boggs*.

With respect to independent claim 98 and 102, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *Nemirofsky* in view of *Boggs*. Specifically, the device of *Boggs* is a toy camera that does not receive signals beyond standard light. (See Abstract, Col 1 lines 5-7, and Col 1 line 31 – Col 2 line 12.) *Boggs* teaches away from receiving video signals as in *Nemirofsky* because light is reproduced from the device upon user actuation. (See Col 3 lines 37-43.) In contrast, *Nemirofsky* captures video signals (i.e., light) with auxiliary data during activation. (See Col 5 lines 39-50.) Thus, *Nemirofsky* teaches away from the combination with *Boggs*.



Accordingly, it is respectfully submitted that this rejection under §103 should be withdrawn as to claims 71, 76, 81, 89, 97, 98, 100 and 102. Claims 72-74 depend from claim 71, claims 77-80 depend from claim 66, claims 82-88 depend from claim 81, claims 90-97 depend from claim 89, all of which add further structural elements thereto. Claim 99 depends from claim 98, adding further method limitations thereto. The rejections should be withdrawn from these claims as well.

Applicants have made a sincere and earnest effort to advance the prosecution of this case to allowance. Such action is now believed to be in order. Should there be any remaining informalities or issues, it is submitted that this may be handled by Examiner's Amendment or that the Examiner should accordingly initiate a telephone conference with the Applicants' under signed attorney Randy L. Canis. Applicants stand ready to cooperate as fully as possible to advance the prosecution of this case to allowance.

Respectfully submitted,

3/4/04  
Date

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